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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,114	04/26/2002	Stefano Bongrani	217836US0PCT	6595

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[REDACTED] EXAMINER

KILLOS, PAUL J

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 07/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



## UNITED STATES DEPARTMENT OF COMMERCE

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER \_\_\_\_\_

ART UNIT \_\_\_\_\_ PAPER NUMBER \_\_\_\_\_

## DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined       Responsive to communication filed on \_\_\_\_\_       This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

## Part II SUMMARY OF ACTION

1.  Claims 1-5 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims \_\_\_\_\_ are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_ has been  approved;  disapproved (see explanation).

12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received.  been filed in parent application, serial no. \_\_\_\_\_, filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other \_\_\_\_\_

## EXAMINER'S ACTION

**REJECTION 35 U.S.C 112, 2<sup>ND</sup> PARAGRAPH, FAILURE TO PARTICULARLY POINT OUT AND DISTINCTLY CLAIM**

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**USE CLAIMS**

Claims 1-3 provide for the use of compounds of claim 11, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

**STATEMENT OF STATUTORY BASIS 35 U.S.C 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

**102 (b) ACTIVITY MORE THAN ONE YEAR PRIOR TO FILING**

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**REJECTION, 35 U.S.C 102(b) PATENT OR PUBLICATION**

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2, 123410 published 01 Feb 1984 or WO 96/29065 published 26 Sept 1996. Both references teach the compounds, and pharmaceutical composition, ~~No~~ patentable weight is given to the "use". See example 3 of the GB patent, and WO page 3 line 12.

U.S. pat. 5,314,916 is cited to show that analogous compounds are used for the treatment of glaucoma.

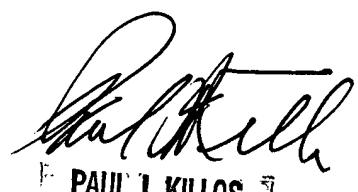
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Killos whose telephone number is 703-308-0135. The examiner can normally be reached on Tuesday-Friday; alternate Mondays 9 am-3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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Killos/tgd  
July 15, 2003

  
PAUL J. KILLOS  
PRIMARY EXAMINER